

Application No.: 10/625,427
Amendment dated: September 28, 2004
Reply to Office Action of July 14, 2004
Attorney Docket No.: 21295.62 (H5650US)

b.) Remarks

Claims 1-12 were pending in this application. Claims 5 and 6 have been cancelled. New Claims 13 to 32 have been added to alternatively define Applicant's invention. New independent claim 13 is an incorporation of claim 5 into independent claim 1, and is now believed to be in allowable form. New independent claim 23 is an incorporation of claim 6 into independent claim 1, and is now believed to be in allowable form. Claims depending from new independent claims 13 and 23 find support in the claims depending from claim 1.

Turning now to the merits, the Patent Office has indicated that claims 5 and 6 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. This has been done, claim 13 in the case of claim 5, and claim 23 in the case of claim 6. It is submitted that dependent claims 14-22 and 24-32 are also in condition for allowance, since they depend on claims which are allowable.

Claims 1-4 and 7-12 were rejected under 35 U.S.C. 103(a) over Neumann et al (U.S. 4,595,829). Applicant respectfully disagrees.

For an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case of obviousness. The Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the cited publications, which must have a suggestion, teaching or motivation for one of ordinary skill in the art to modify a reference or combined references.¹ The cited publications should explicitly provide a reasonable expectation of success, determined from the position of one of ordinary skill in the art at the time the invention was made.²

¹ In re Sang Su Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

² In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); In re Wilson, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); Amgen v. Chugai Pharmaceuticals Co., 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996);

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Applicant submits that the Patent Office has not met the burden of establishing a prima facie case of obviousness. As it was stated in *In Re Lee* that "[B]oard of Patent Appeals and Interferences improperly relied upon 'common knowledge and common sense' of person of ordinary skill in the art to find invention of patent application obvious over combination of two prior art references . . ." ³ The court went on to say: "[I]n its decision on Lee's patent application, the board rejected the need for 'any specific hint or suggestion in a particular reference' to support the combination of the Northrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action."⁴ The Applicant respectfully invites the Patent Office to cite column and line number from within the cited references as to where such a teaching may be found.

The Applicant would also like to bring to the Patent Office's attention that "[O]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination."⁵

Specifically, the Patent Office states: "[A]lthough Neumann does not specifically mention the use of a cylindrical lens, the specific lens utilized would have been obvious to one of ordinary skill in the art in view of design requirements and the desired performance." If the presence of "design requirements and desired performance" were an actual test for obviousness, then if one were to invent a time machine, it would be obvious in view of H.G. Wells' "The Time Machine", and countless other science fiction books and movies. The Neumann patent must be considered in its entirety for what it teaches. What does Neumann teach with respect to lines? The Applicant draws the Examiner's attention to Fig. 2, col. 3, lines 48-51, col. 6, lines 14-23, and claim 6. Throughout the document, Neumann makes it clear that his marker lines are lines on a

³ 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

⁴ *Id.* at 1434.

⁵ *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986) (citing *ACS Hosp. Syss., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed Cir. 1984).

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glass disk "applied in the manner of the face of a timepiece" (col. 6, lines 16-17).
Nowhere does Neumann teach or suggest that these marker lines may consist of a line fashioned from a beam of light. Neumann has no need for a cylindrical lens to create these lines. Therefore, the Patent Office has not met its burden of making a prima facie case of obviousness with regard to Claim 1 and the rejection of Claim one should be withdrawn. Claims 2-4 and 7-12 depend off now allowable Claim 1 and should be allowed.

Applicant believes that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

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